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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,356	12/01/2000	Gerard Alan Lynch	20228-302	4120

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EXAMINER
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AL HASHEMI, SANA A

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/728,356

Applicant(s)

LYNCH, GERARD ALAN

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to the oral election by applicant Claims 17-26 are presented for examination.

Claim Status: 17- 26, are rejected.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, and 6-16, drawn to the method of listing an item on an auction site, classified in class 705, subclass 27.

II. Claim 5, drawn to the method of re-listing a previously listed auction item that did not sell, classified in class '705, subclass 27.

111. Claims 17-26, drawn to the method of linking an item description to an item posted on an auction site, classified in class 707, subclass 2+. The inventions are distinct, each from the other because of the following reasons:

Inventions II, III, and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions II, III, and I are drawn to separate and patentable distinct subject matter. The invention of Group I is drawn to a method of listing an auction item. The invention of Group II is drawn to a method of re-listing, and auction item that had already been listed, but did not see I, and Group III is drawn to a method of linking an item description to an item posted on an auction site. Each of these inventions is independent and distinct from the other two.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Anthony Diepenbrock III on May 28, 2003 a provisional election was made without traverse to prosecute the invention of Group 111, claims 17-26. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

### *Specification*

Claim 21 objected to under 37 CFR 1.75(c), as being of improper dependent from it self. Examiner will that the claim as being dependent on claim 17.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 18, and 21- 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hess et al. (US Patent No. 6,415,320).

1. Regarding Claims 17, 21, 23, and 25, Hess discloses a method of linking an item description to an item posted to an auction site, comprising:

embedding encoded search information for the posted item into a pointer to an auxiliary site (see Fig. 6B, 650, Hess);

embedding the pointer in an item description of a linking item (see Fig. 9A, 960, Hess);

posting the linking item to the auction site (see Fig. 9A, 5, Hess);

finding the linking item with the pointer at the auction site (see Fig. 9B, 915);

upon selection of the pointer, accessing the auxiliary site (see Fig. 9A, help button 900, Hess);

decoding the search information into readable text at the auxiliary site (see column 4, lines 19-23, Hess); and

upon selection of the readable text, invoking a search engine of the auction site with the decoded search information as a search parameter to find the posted item and item description (see column 6, lines 29-40, Hess).

2. Regarding Claim 18, Hess discloses a method of linking an item description to an item posted to an auction site, wherein the pointer is a uniform resource locator (see column 4, lines 11-18, Hess).

3. Regarding Claims 22, and 26, Hess discloses a method of linking an item description to an item posted to an auction site, wherein the step of posting the linking item to the site includes:

(a) obtaining actual item description data and actual item auction parameter data for the linking item (see Fig. 9A, 5, Hess);

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(b) retrieving a stored item number, item key, user id and user password (see Fig. 6A, 605, 610, Hess); and

(c) submitting to the site confirmation data that includes actual item description data, actual auction parameter data, the retrieved item number, retrieved item key, the user id and the user password to post the linking item for sale to the site (see Fig. 9B, 900, Hess).

4. Regarding Claim 24, Hess discloses a method of linking an item to an item posted to an auction site, wherein the pointer is an HTML in-line frame tag (see column 4, lines 19-23, Hess).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al. (US Patent No. 6,415,320, and further in view of Kumar et al. (PAP No. 2002/0143634).

5. Regarding Claim 19, Hess discloses all of the claimed subject matter, Hess does not explicitly disclose the method of linking an item description to an item posted to an auction site, wherein the encoded search information is in the form of ASCII codes for the readable text. However, Kumar et al discloses the use of ASCII form (see paragraph 0029, Kumar). It would have been obvious to one of ordinary skill in the art at the time of the invention to add/modify

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the coding in Hess by using the ASCII form in coding user information, with the motivation of securing the user ID and password as defined in the extended ASCII character set.

6. Regarding Claim 20, the combination of Hess/ Kumar discloses a method of linking an item description to an item posted to an auction site, wherein the encoded search information is encrypted information (see paragraph 0060. Kumar); and

wherein the step of decoding the search information includes decrypting the search information (see paragraph 0062, Kumar).

***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-9098. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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September 8, 2003

  
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